

**REMARKS**

In response to the Office Action dated March 17, 2008, Applicants hereby provisionally elect Claims 1 - 4 for examination. Applicants also submit amendments to Claims 1-4 to address formatting and other issues consistent with domestic practice in the event the restriction requirement is not withdrawn.

While not conceding the propriety of the restriction requirement, Applicants make this election with traverse and for the sole purpose of advancing the application in the examination process. In this regard, Applicants wish to note that restriction is not "required" by 35 U.S.C. §121 as implied by the Examiner. Congress wisely gave the Commissioner administratively constrained "discretion" to impose restriction, when appropriate. According to 35 U.S.C. § 121 "... the Commissioner may require claims in an application to be restricted...." (emphasis added). In other words, the Commissioner is not required to restrict claims in an application. Likewise, the MPEP § 803 lists two criteria that must be present for restriction between alleged claim groups to be proper:

- 1) The invention in allegedly "restrictable" or "separable" claim groups must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

Applicants respectfully assert that restriction is not proper here because, among other things, the Examiner has failed to establish the claims as she has grouped them are sufficiently distinct to warrant restriction or the Examiner has failed to show that there will be a serious burden on the Examiner if the claims are examined together. In particular, Applicants submit that examination of any one of the three alleged claim groups will in all likelihood require a search and evaluation of substantially the same prior art as an examination of either or both of the other two groups. Each would require searching all of the art relating the preparation of tamsulosin. Furthermore, separate examination of the three claim groups may lead to inconsistent examinations and will no doubt result in duplication of effort. It is a more efficient

U.S. Application No. 10/584,651

use of Patent Office manpower and resources to examine all claims which are closely related at one time, rather than conducting separate examinations.

The mere fact that two sets of claims are allegedly directed to methods and another set is directed to a product or composition which may be used in or made by the claimed methods does not mean a patent cannot properly be issued containing all sets of claims. Patents are routinely validly issued containing both method and product/composition claims.

Because the Examiner has not shown that the claims are sufficiently distinct or she has not shown that she would be seriously burdened if she examines all the claims in one proceeding, Applicants respectfully submit that restriction is not proper in this case and they urge the Examiner to reconsider and withdraw the restriction requirement and examine Claims 1 - 10 on the merits.

If the Examiner identifies further issues which may be resolved by telephone, the Examiner is invited to contact the undersigned at (865) 546-4305.

In the event that this response is not timely filed, Applicants hereby petition for an appropriate extension of time. The fee for this extension, along with any other fees which may be due with respect to this response, may be charged to our Deposit Account No. 12-2355.

Respectfully submitted,

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*E-Filing*